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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/232,488	01/15/1999	DONNA E. PRUNKARD	PPL-1REISSUE	1781

7590 10/05/2005

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EXAMINER

CROUCH, DEBORAH

ART UNIT PAPER NUMBER

1632

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/232,488

Applicant(s)

PRUNKARD ET AL.

Examiner

Deborah Crouch, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ = is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/15/99 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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The Art Unit location of this application has changed. All further communications should be sent AU 1632, Deborah Crouch, Ph.D.

Interference 104,242 has terminated with a decision adverse to applicant. *Ex parte* prosecution is resumed.

The amendment filed April 1, 1999 has not been entered per applicant's request. Particularly applicant stated that if the Board of Interferences denies Garner Motion No. 2, then Garner will add the claims of the amendment (claims 35-37, directed to methods and mammals comprising cDNA sequences encoding human fibrinogen A α chain, B β chain and γ -chain). However, as the Board found the claims to be unpatentable, these claims have not been entered.

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

the oath filed January 15, 1999 does not state that the signer have 1) reviewed the specification and claims as amended and 2) all errors arose without deceptive intent on the part of applicants. In particular, there is no without deceptive intent statement regarding the amendment to "heterologous" genomic segments in claims 30.

Claims 1-34 are rejected as being based upon a defective reissue oath under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath is set forth in the discussion above in this Office action.

Claims 1-34 are rejected under 35 U.S.C. 251 and 37 CFR 1.658 as corresponding to the count lost in Interference No. 104,242. Applicants did not file a request for reconsideration of this decision within one month after the date of the decision under 37

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CFR 1.658(b), or file an appeal to the Court of Appeals for the Federal Circuit or civil action in a United States district court under 35 U.S.C. 141 or 146 respectively. The judgment of the Board of Patent Appeals and Interferences stands, see 37 CFR 1.658(a). It is noted according to 37 CFR 1.658(c) that this judgment settles all issues which were raised and decided in the interference. A second interference is not permissible to decide the same issues. See also MPEP 2358.

Claims 1-34 are further objected to under 37 CFR 1.633 on the grounds of estoppel. As noted above, the Judgment in Interference No. 104,242 determined that the parent, U.S. Patent 5,639,940, was not entitled to a patent containing claims 1-33 of, which correspond to the count). Present claims 1-34 also correspond to the count and thus are prevented from prosecution on the grounds of estoppel.

Claims 1-34 are rejected under 35 USC 103 as unpatentable was made by the Board of Patent Appeals and Interferences in Interference proceeding 104,242 and was affirmed on appeal to the CAFC (I-104,242, paper 110). As the pending claims are the same as, or of similar scope, to those for which this rejection was affirmed, the CAFC decision stands as *res judicata* on these claims. A Board of Patent Appeals and Interferences decision in an application has res judicata effect and is the "law of the case" and is thus controlling in that application and any subsequent, related application. Therefore, a submission containing arguments without either an amendment of the rejected claims or the submission of a showing of facts will not be effective to remove such rejection. See MPEP § 706.03(w).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Crouch, Ph.D. whose telephone number is 571-272-0727. The examiner can normally be reached on M-Th, 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, Ph.D. can be reached on 571-272-0735. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Deborah Crouch, Ph.D.
Primary Examiner
Art Unit 1632

September 30, 2005